

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Aya JAKOBOVITS et al.

Application No.: 09/771,312

Confirmation No.: 7650

Filed: January 26, 2001

Art Unit: 1642

For: 84P2A9: A PROSTATE AND TESTIS
SPECIFIC PROTEIN HIGHLY EXPRESSED IN
PROSTATE CANCER

Examiner: B. Fetterolf

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

On behalf of applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Notice of Allowance. This application for patent term adjustment is being filed with payment of the issue fee and is, therefore, timely. The fee required under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants respectfully request an additional credit of 692 days be added to the 606 days of adjustment as indicated on the Notice of Allowance. The additional credit, minus applicants' delay, results in a revised total of 1298 days of patent term adjustment.

Statement of Facts

According to the Office's Initial Determination of Term Adjustment received with the Notice of Allowance, mailed September 15, 2008, applicants are entitled to 606 days adjustment of patent term. Applicants disagree with the Patent Term Adjustment of 606 days and reconsideration is respectfully requested.

The Office failed to mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 within 14 months of the filing date of the present application. The Office correctly credits applicants 813 days of adjustment in accordance with 35 USC 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1), 1.703(a)(1).

Applicants filed a response on May 28, 2002 to a notice to file missing parts, mailed January 10, 2002. Applicants calculate 48 days of delay, but the Office incorrectly calculates 61 days of applicants' delay. Applicants assert that the correct number of days of delay is 48 in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on March 24, 2005 to a restriction requirement, mailed December 15, 2004. The Office correctly calculates 9 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on October 13, 2005 to a non-final office action, mailed May 4, 2005. The Office correctly calculates 70 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a request for continued examination on November 3, 2006 in response to a final rejection, mailed June 28, 2006. The Office correctly calculates 36 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a notice of appeal on August 7, 2007 in response to a final rejection, mailed February 12, 2007. The Office correctly calculates 87 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a Supplemental Information Disclosure Statement on March 21, 2008. The Office correctly calculates 14 days of applicants' delay in accordance with 37 CFR 1.704(c)(8).

Applicants filed a Supplemental Information Disclosure Statement on November 10, 2008. The Office has not calculated a delay based on the Supplemental Information Disclosure Statement, however, applicants calculate 120 days of applicants' delay in accordance with 37 CFR 1.704(c)(10). Applicants understand that should the Office issue a response or should the application issue prior to the projected date of March 24, 2009, the 120 days of delay will be reduced accordingly.

Based on a projected issue date of March 24, 2009, the Office will fail to issue a patent within 3 years after the date on which the present application was filed (January 26, 2001). Based on this projected issue date, applicants are entitled to an additional credit of 1011 days in accordance with 35 USC 154(b)(1)(B) and 37 CFR 1.702(b), 1.703(b).

Under the USPTO's Exclusion Interpretation of 35 USC 154(b)(2)(A) and application of 37 CFR 1.703(f) Actual Delay Limitation, the Office would conclude that the 813 days of adjustment for failure to issue an action constitute "overlap" with the 1011 days of adjustment for failure to issue a patent within 3 years and thus, would not include the 813 days in the total calculation of term adjustment.

In light of Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008), applicants assert that the Actual Delay Limitation under 37 CFR 1.703(f) is no longer applicable and thus, the 813 days of delay under the 14-Month PTO First Action rule should be added to the 1011 days of delay under the 3-Year PTO Issue of Patent rule.

Applicants calculate a total PTO delay of 1682 days and applicants' delay of 384 days, for a revised total of 1298 days of additional patent term. Based on the foregoing information, applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.

511582000100.

Dated: December 15, 2008

Respectfully submitted,

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